1FW 3635

Docket No.: 408-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Enrique Molina	)	
		)	Art Unit 3635
Serial No.:	09/995,486	)	
		)	Examiner:
Filed:	November 28, 2001	)	Jeanette E. Chapman
		)	
For:	BUILDING CONSTRUCTION SYSTEM	)	

The Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service as **First Class Mail** in an envelope Alexandria, Virginia 22313-1451addressed to: The Commissioner for Patents, P.O. Box 1450,Alexandria, Virginia 22313 on August 16, 2007.

By: _____

RESPONSE TO MAY 16. 2007 OFFICE ACTION

This is in response to the outstanding office action of May 16, 2007 in which the examiner cites another new reference; rejects the remaining amended claims based on the new reference (but overlooks claim 17 that depends on claim 48 as of the time of her examination); and still does not respond to Applicant's request to reinstate withdrawn claims 9-10, 14-16, 28-29, and 31-35 that were previously presented as amended.

Since dependent claim 17 depended on claim 48 at the time the examiner acted on this case, claim 17 should have been acted on in the outstanding office action. Claims 2, 8, 11-13, and 30 stand cancelled and claims 18-27 and 36-47 stand withdrawn as non-elected restricted claims.

Page 20 of the written disclosure is amended to expressly support claim language.

Amended claims 1, 3-7, and 48-50 are rejected under 35 U.S.C. § 102(e) as being anticipated by Meilleur (U.S. Patent 6,070,380). Added new claims 51 and 52 depend from claim 48, and claim 53 and 54 depend from claim 1.

Because the first request was overlooked, Applicant requests, a second time, that the examiner reinstate claims 9-10, 14-16, 28-29, and 31-35 as presented. And if the claims are not reinstated, Applicant requests an explanation.

Request to Reinstate Claims 9-10, 14-16, 28-29, and 31-35

Independent claim 9, as amended, is directed to a "grid device for horizontally disposing reinforcement rods in a poured-in-place wall mold cavity formed on a building site and defined by opposed molding surfaces of opposed vertically disposed wall molding panels," and is currently amended to include the limitations of former claim 12 and of currently amended claim 10. Claims 14-16 depend from independent claim 9 and further limit the claimed grid device to necessarily be part of Applicant's invention of claims 1, 3-7, 17, and 48-50 that require use of the claimed grid device of claims 9 and 14-16. No further search is required by the examiner to act on Applicant's claimed grid device that has no other purpose than to be part of the assembly of claims 1, 3-7, 17, and 48-50.

The original requirement for restriction of Group II claims 9-16 was based on being drawn to an invention classified in class 52, subclass 677 while the Group I claims 1-8 was based on being drawn to an invention classified in class 249, subclass 40. The former examiner then proceeded to make the restriction of the invention on the basis of a species restriction without a generic claim in citing MPEP Sections 806.04(b) and 806.04(h).

MPEP Section 806.04 reads:

> Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct. However, 37 CFR 1.141 provides that an allowable generic claim may link a reasonable number of species embraced thereby. The practice is set forth in 37 CFR 1.146.

MPEP Section 806.04(d) defines a generic claim as follows.

> In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or

subcombination common to the several species.

> In general, a generic claim should require no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim.

MPEP Section 806.04(h) states when multiple species must be patentably distinct.

> In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other.

Applicant's application illustrates the claimed assembly and grid device in his Figures 3 and 4 that do not show more than one species of the grid device that is necessarily used in the claimed assembly. The inventions of Groups I and II are ***NOT*** "mutually exclusive species in an intermediate final product" when the assembly is the final product and the grid device is an essential part of the claimed final product. To be a complete search, both classes, namely, class 52, subclass 677 and class 249, subclass 40, should have been searched for the claimed Group I invention since both sets of claims relate to a poured-in-place wall structure mold cavity formed on a building site.

In view of the foregoing, Applicant respectfully requests that claims 9-16, as amended, be reinstated in the application and deemed allowable for the reasons stated in his response to the rejection of Applicant's claims over Meilleur.

Claims 28, 29 and 31-35 are directed to a "method for producing on a building site a vertically disposed poured-in-place wall structure having horizontally disposed reinforcement rods" that provides wall molding means that define a mold cavity, and "a plurality of separate grid means having two edges for extending vertically along the vertically disposed molding surfaces and being sufficiently rigid for freely positioning and retaining said reinforcement rods horizontally along said first molding surface at a preselected horizontal location laterally spaced from said first molding surface and at preselected vertical locations spaced along said first molding surface."

The former examiner said that "the process for using the product [assembly] as claimed can be practiced with another materially different product" ***or*** "the product as claimed can be used in a

materially different process of using the product" and cited MPEP Section 806.05(h). The examiner then states that in "the instant case a forming method can be accomplished by chiseling rough concrete." The method of using Applicant's claimed assembly ***CANNOT*** be "practiced with another materially different" assembly. For the claimed process specifically provides the product that is set forth in the Group I assembly claims. So the process cannot be practiced "with another materially different product" as alleged. Moreover, the examiner's suggested "forming method" of "chiseling rough concrete" is incomprehensible.

In view of the foregoing, Applicant respectfully requests that method claims 28, 29, and 31-35, as amended, be reinstated in the application and deemed allowable for the reasons stated in his response to the rejection of Applicant's claims over Muilleur.

AMENDMENT TO WRITTEN DISCLOSURE

In the written disclosure, page 20, 5-16, amend the paragraph to read as follows:

The poured-in-place forming process of the invention thus includes vertically disposing first wall forming panel 22 to provide a first molding surface along one side of a wall mold cavity. Then attaching a first edge of a plurality of reinforcement rod suspending elements 25 to extend upwardly along the first wall forming panel 22 and to project outwardly from the first molding surface. As is evident in the drawings and this disclosure, reinforcement suspending elements or grid elements 25 are separable from the assembly. Then freely positioning the reinforcement rods to horizontally rest on the rod suspending tie members 28 at a spaced horizontal distance from the first molding surface and at a plurality of preselected vertical locations spaced upwardly along the first molding surface. Then vertically disposing second wall forming panel 30 opposed to the first wall forming panel 22 to provide a second molding surface facing the first molding surface.

Version showing changes made in the original written description.

The poured-in-place forming process of the invention thus includes vertically disposing first wall forming panel 22 to provide a first molding surface along one side of a wall mold cavity. Then attaching a first edge of a plurality of reinforcement rod suspending elements 25 to extend upwardly along the first wall forming panel 22 and to project outwardly from the first molding surface. As is evident in the drawings and this disclosure, reinforcement suspending elements or grid elements 25 are separable from the assembly. Then freely positioning the reinforcement rods to horizontally rest on the rod suspending tie members 28 at a spaced horizontal distance from the first molding surface and at a plurality of preselected vertical locations spaced upwardly along the first molding surface. Then vertically disposing second wall forming panel 30 opposed to the first wall forming panel 22 to provide a second molding surface facing the first molding surface.